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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,834	03/25/2004	Ray F. Barnard	END919990117US2	6741

44755 7590 01/27/2006

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EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/808,834

Applicant(s)

BARNARD ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 36-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This final Office action is responsive to Applicant's amendment filed December 15, 2005.

Claims 1, 36, and 38-41 have been amended.

Claims 1, 2, and 36-41 are presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed December 15, 2005 have been fully considered but they are not persuasive.

Applicant argues that Gundewar is not used to build the templates required for the specific applications recited by Applicant (e.g., reengineering a customer's process, conducting gap analysis, etc.) (Page 14 of Applicant's response) However, as stated in the art rejection, these applications amount to nothing more than mere intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed

to be patentably distinct over the prior art. The recently added limitation, "in conducting a gap analysis with respect to said customer application and an enterprise model, and responsive to said gap analysis in reengineering said customer application," fails to add any functionality specific to each application. How are the templates used to accomplish functionality that is particularly relevant to these applications? Applicant does not clearly set forth any limitations that make the recited applications into more than mere intended use.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, and 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recently added limitation, "in conducting a gap analysis with respect to said customer application and an enterprise model, and responsive to said gap analysis in reengineering said customer application" (recited in all of the claims), fails to add any functionality specific to each application. How are the templates used to accomplish functionality that is particularly relevant to these applications? Applicant does not clearly set forth any limitations that make the recited applications into more than mere intended use. Consequently, the scope of Applicant's desired claim coverage is unclear. What steps are expressly performed as part of gap analysis and reengineering

of the customer application, as intended by Applicant? These steps should be expressly recited to clarify the metes and bounds of these features. Otherwise, these features will continue to be interpreted as mere intended use.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, and 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gundewar et al. (U.S. Patent No. 6,381,610).

Gundewar discloses a system using an on-line data gathering tool for developing an application, comprising:

[Claim 1] a server (Fig. 1, #12);

a storage device connected to said server (Fig. 1, #20, 22, 24, 26, 28, 29);

a plurality of team terminals (Fig. 1, #14, 16, 18);

a communication link interconnecting said server and said terminals (Fig. 1, #21, 30);

said server being operable for (1) maintaining a database of templates describing procedures for developing said application on said storage device and (2) serving said templates to enterprise and customer team members operating said terminals for

coordinating, recording and tracking team activities with respect to said application (Fig. 1; col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- A project may be tracked from the planning through the completion stages and the related activities may be documented using various templates);

said server defining and guiding said team members in analyzing conditions that exist within a customer application (Fig. 1; col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- A project may be tracked from the planning through the completion stages and the related activities may be documented using various templates. The templates facilitate the stages and activities related to the project, or the customer application, thereby assisting in defining and guiding the team members in analyzing the project);

[Claim 2] each said template storing, either directly or by way of links to other documents, materials for guiding, coordinating and documenting the work of said team members (Fig. 1; col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- A project may be tracked from the planning through the completion stages and the related activities may be documented using various templates).

As per claim 1, while Gundewar discloses that the stored and created templates are used for project management applications, Gundewar fails to expressly teach that the specific type of project management applications include a general procurement and accounts payable application or a gap analysis with respect to said customer application and an enterprise model, responsive to said gap analysis in reengineering said customer application. However, these limitations merely recite various intended uses of

the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art. Furthermore, the Examiner submits that general procurement and accounts payable applications are commonly utilized as part of project management planning. For example, many projects are limited by constraints related to costs, including accounts payable, and the ability to obtain needed resources, i.e., general procurement. In order to more fully understand the limitations imposed on a project as a whole and the likelihood of achieving project goals, a more comprehensive analysis of all factors affecting the project is required. Since Gundewar is already directed toward project management and therefore suggests the incorporation of factors related to project management, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar to include a general procurement and accounts payable application as part of its project management templates system in order to assist users involved with the planning of a particular project in more fully

understanding the limitations imposed on a project as a whole and the likelihood of achieving project goals, thereby yielding a more comprehensive analysis of all factors affecting the project. Additionally, Official Notice is taken that gap analysis and reengineering are commonly performed in order to assess and improve the performance of an organization. Since Gundewar's users are attempting to efficiently plan and manage a project, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar's templates to be specifically applicable to conducting gap analysis and reengineering in order to help assure that the progress of the project is sufficiently aiding improvement in the performance of an organization (e.g., with respect to completion of the project).

Gundewar discloses a system using an on-line data gathering tool for developing an application, comprising:

[Claim 36] a server (Fig. 1, #12);

a storage device connected to said server including a database of templates initially configured as an application (Fig. 1, #20, 22, 24, 26, 28, 29);

a plurality of team terminals including a service provider team terminal and a customer team terminal (Fig. 1, #14, 16, 18);

a communication link interconnecting said server and said terminals (Fig. 1, #21, 30);

a server means defining and guiding said team members in analyzing conditions that exist within a customer application (Fig. 1; col. 4, lines 15-51; col. 5, line 42 through



col. 8, line 11 -- A project may be tracked from the planning through the completion stages and the related activities may be documented using various templates. The templates facilitate the stages and activities related to the project, or the customer application, thereby assisting in defining and guiding the team members in analyzing the project);

[Claim 37] each said template storing, either directly or by way of links to other documents, materials for guiding, coordinating and documenting the work of said team members (Fig. 1; col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- A project may be tracked from the planning through the completion stages and the related activities may be documented using various templates).

As per claim 36, while Gundewar discloses that the stored and created templates are accessed by clients via a server and various server means (col. 3, lines 9-23), used for project management applications such as tasks related to states of "Define, Analyze, Design, Produce, Optimize, Implement, and Manage" (col. 4, lines 34-51), and customizable to each user's specific needs (col. 4, lines 14-24), Gundewar fails to expressly teach that the specific type of project management applications include a general procurement and accounts payable application, including task templates for project design and development of assessment, business controls, configuration, education, image, information technology, marketing, process, requisition and catalog, accounts payable accounting and transition tasks. Gundewar also fails to expressly teach that the specific type of project management applications include a gap analysis

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with respect to said customer application and an enterprise model, responsive to said gap analysis in reengineering said customer application. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art. Furthermore, the Examiner submits that general procurement and accounts payable applications, including task templates for project design and development of assessment, business controls, configuration, education, image, information technology, marketing, process, requisition and catalog, accounts payable accounting and transition tasks, are commonly utilized as part of project management planning. For example, many projects are limited by constraints related to costs, including accounts payable, and the ability to obtain needed resources, i.e., general procurement. In order to more fully understand the limitations imposed on a project as a whole and the likelihood of achieving project goals, a more comprehensive analysis of all factors affecting the project is required. Since Gundewar is already directed toward

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project management and therefore suggests the incorporation of factors related to project management, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar to include a general procurement and accounts payable application, including task templates for project design and development of assessment, business controls, configuration, education, image, information technology, marketing, process, requisition and catalog, accounts payable accounting and transition tasks, as part of its project management templates system in order to assist users involved with the planning of a particular project in more fully understanding the limitations imposed on a project as a whole and the likelihood of achieving project goals, thereby yielding a more comprehensive analysis of all factors affecting the project. Additionally, Official Notice is taken that gap analysis and reengineering are commonly performed in order to assess and improve the performance of an organization. Since Gundewar's users are attempting to efficiently plan and manage a project, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar's templates to be specifically applicable to conducting gap analysis and reengineering in order to help assure that the progress of the project is sufficiently aiding improvement in the performance of an organization (e.g., with respect to completion of the project).

[Claims 38-41]      Claims 38-41 recite limitations already addressed by the rejection of claim 36 above; therefore, the same rejection applies.

***Conclusion***


7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

January 20, 2006